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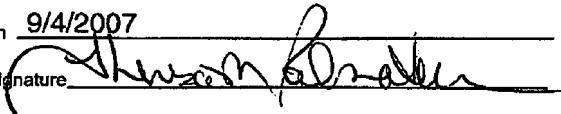
SEP 04 2007

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  67,108-017; Bogdan 2-1-1-1
<b>CERTIFICATE OF FACSIMILE</b> I hereby certify that this Pre-Appeal Brief Request For Review and Notice of Appeal are being facsimile transmitted to (571) 273-8300. on <u>9/4/2007</u> Signature  Typed or printed <u>Theresa M. Palmateer</u> name _____		Application Number  10/648,909  Filed  08/27/2003
First Named Inventor  <b>Brian J. Bogdan</b>		Art Unit  2193  Examiner  Wood, William H.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record.  
Registration number 37,139

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

David J. Gaskey

Typed or printed name

(248) 988-8360

Telephone number

9/4/2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.



\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Brian J. Bogdan

Serial No.: 10/648,909

Filed: 08/27/2003

Group Art Unit: 2193

Examiner: Wood, William H.

For: FIRMWARE MANAGEMENT TOOL

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby requests Pre-Appeal Brief Review of the Final Office Action mailed on June 4, 2007 because the rejection under 35 U.S.C. §112, first paragraph, apparently does not take into account what is contained in Applicant's disclosure and there is no *prima facie* case of obviousness under 35 U.S.C. §103 against any of Applicant's claims.

The Examiner has rejected claims 1-18 under 35 U.S.C. §112, first paragraph. The Examiner contends that "assigning a part number to the firmware file that provides an indication that the firmware file is ready to be burned onto a chip and wherein the firmware file cannot be accessed to be burned onto a chip if the part number is not associated with the firmware file," is not supported by Applicant's written description. This subject matter is supported by Applicant's disclosure.

For example, page 2, lines 2-3, indicate that a firmware file status of "Public" is a status where the firmware file is "ready for compiling and burning onto chips." Lines 9-11 of page 2

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indicate that, "The inventive firmware management tool adds a layer of control and monitoring over a firmware development process, insuring that the object code sent to a chip manufacturer is the correct, final version of the code." In other words, Applicant's specification indicates that object code sent to a chip manufacturer, which is for purpose of burning onto a chip, is controlled to only occur when the final version of the code, which is ready to be burned onto a chip, is ready. Such access to the firmware file for purposes of burning it onto a chip does not occur too early.

Page 4, line 3, indicates that during early development stages a firmware file is "private" and "accessible only to the designer." Page 4, lines 19-21 indicate that a firmware file can then be changed from the early "private" status to a "test" status so that it can be reviewed by a review group. Page 4, lines 28-30 indicate, "If the review group approves the request [for approval], the firmware file status is changed to "public," indicating that the firmware file is ready to be implemented onto an integrated circuit (block 258)." As indicated in lines 30-32, if the review group denies the request to provide a "public" status to the firmware file a message may be sent back to the designer indicating reasons for that decision. Page 5, lines 9-12, state, "Once the review group and designer have reached a consensus that the coding in the firmware file is ready to be burned onto a chip, the status of the file is changed to 'public,' as explained above with respect to Figure 3 (block 25). The tool 100 assigns a part number to the firmware file." According to lines 23-30 of page 5, "Once all of the designing and editing is complete, a given firmware file will have archived source code and archived object code that has been made publicly available within the system and having an assigned part number. The object code is therefore read [sic, ready] to be sent to the chip manufacturer to be burned on chips. Because the object code is obtained from a firmware file that has been created and reviewed under tight

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controls (e.g., via controlling the status, accessibility, and work flow via the firmware management tool 100), the final object code has already been reviewed multiple times, reducing the likelihood that the code is outdated or otherwise incorrect.”

From the above quoted portions of the disclosure, it is clear that a part number is assigned to a firmware file when the firmware file is given the status that corresponds to it being ready to be sent to a manufacturer to be burned onto a chip. Assigning the part number is providing an indication that the firmware file is ready to be burned onto a chip. Additionally, it is clear from the above-quoted portions of the description that a firmware file cannot be given the status that allows it to be accessed to be burned onto a chip until it is ready for that status. Once that status is proper, the part number is associated with the firmware file. If that status is not proper, the part number is not associated with that file. In other words, the firmware file cannot be accessed to be burned onto a chip if the part number is not associated with the firmware file. Therefore, the language that the Examiner is contending is not supported by the written description is, in fact, well supported by the description and the rejection under 35 U.S.C. §112 must be withdrawn.

There is no *prima facie* case of obviousness against any of Applicant’s claims. The Examiner proposes to combine the *Barturen, et al.* and *Piazza* references for purposes of rejecting claims 1-2 and 6-11. The proposed combination cannot be made and, even if it could, does not provide the result of Applicant’s claimed invention. The *Barturen, et al.* reference is concerned with a software delivery process “from development to installation in production.” The *Piazza* reference is concerned with ensuring firmware compatibility when upgrading firmware after it has been installed. That would be after the “installation in production” of the *Barturen, et al.* reference. Therefore, the teachings of the *Piazza* reference have no usefulness in

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the context of the *Barturen, et al.* reference and would not provide any benefit within the context of the arrangement of the *Barturen, et al.* reference. Post-production issues addressed by the *Piazza* reference do not have anything to do with pre-production processes as discussed in the *Barturen, et al.* reference. Because there would be no benefit to the proposed combination, it cannot be made and there is no *prima facie* case of obviousness.

Even if the combination could somehow be justifiably made, it does not provide the result of Applicant's claimed invention. The Examiner relies upon column 1, lines 38-48 of the *Piazza* reference as teaching that firmware is burned into a programmable read-only memory (PROM). The Examiner is correct in this regard. The Examiner also points to column 2, line 19 and column 2, lines 23-25 of the *Piazza* reference for teaching that it was known to require a part number for firmware. At best, lines 23-25 of *Piazza* indicate that one technique for verifying applicability of a candidate image to an existing installation includes "a part number in a recognizable form and position exists in the candidate image."

There is nothing in either of the *Barturen, et al.* or *Piazza* references that in any way associates the part number with a status of a firmware file that indicates that it is ready to be burned onto a chip. Neither the *Piazza* reference, nor the *Barturen, et al.* reference provide any indication of when the part number would be assigned to the file or that it would have any significance with regard to whether it is ready to be burned onto a chip. Therefore, even if the improper combination of the *Barturen, et al.* and *Piazza* references were made, it is missing the claim limitations regarding having a part number assigned to a firmware file for purposes of indicating that it is ready to be burned onto a chip and the absence of a part number prevents the firmware from being accessed for purposes of burning it onto a chip. Therefore, there is no *prima facie* case of obviousness.

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The Examiner rejects claims 3-5 and 12-18 under 35 U.S.C. §103 based upon the proposed combination of the *Barturen, et al.*, *Piazza* and *Mukherjee* references. The proposed addition of the *Mukherjee* reference to the improper combination of the *Barturen, et al.* and *Piazza* references does not remedy the defects in the base combination already explained. Therefore, there is no *prima facie* case of obviousness against any of these claims, either.

All rejections must be withdrawn.

Respectfully submitted,

CARLSON, GASKEY & OLDS

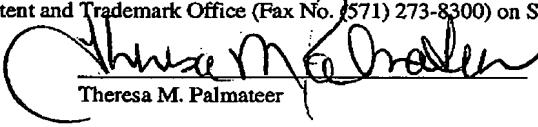
By: 

David J. Gaskey  
Registration No. 37,139  
400 W. Maple Rd., Ste. 350  
Birmingham, MI 48009  
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Dated: September 4, 2007

**CERTIFICATE OF FACSIMILE**

I hereby certify that this Pre-Appeal Brief Request for Review, relative to Application Serial No. 10/648,909 is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on September 4, 2007.

  
Theresa M. Palmateer

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